

REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-12 are pending. Claims 1, 3-5, 7, and 9-11 have been amended. Claims 1 and 7 are independent.

I. Claim Objections

The Examiner objected to claim 7 because “a method is claimed instead of a system.” Applicants have amended the preamble of claim 7 to recite a system.

II. Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claims 1-6 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. According to the Examiner, the claims do not set forth any steps involved in the method/process.

Applicants have amended independent claim 1 to more particularly recite method limitations, such as “generating ... a customer PDF document,” and “analyzing the first and second XML files, merging data, and formatting information.” Therefore, claim 1, and claims 2-6 that depend therefrom, delimit how the claimed method is to be practiced, and the Examiner’s rejection should be withdrawn.

III. Claim Rejections – 35 U.S.C. § 101

The Examiner rejected claims 1-6 under 35 U.S.C. § 101, asserting that “the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process.” Applicants’ above-described amendments to independent

claim 1 ensure that claims 1-6 do not result in an improper definition of a process. Therefore, the Examiner's rejection should be withdrawn.

IV. Claim Rejections – 35 U.S.C. § 103

The Examiner rejected claims 1-12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hansen (U.S. Patent No. 6,509,974) in view of Bowman-Amuah (U.S. Patent No. 6,636,242). Applicants respectfully traverse the rejection; the claims have been merely amended to provide clarity and definiteness.

A. The Claimed Invention

Independent claims 1 and 7 respectively recite a method and system for a customer to create a PDF document and send the PDF document to a service provider. A PDF engine generates a printer-ready PDF document using first and second XML files. The first XML file is created by the customer and includes data for printing and its associated datatype. The second XML file describes how the data is to be positioned and formatted in the created PDF document. The printer-ready PDF document is generated at the site of the customer.

Accordingly, a customer, at the front end, can advantageously participate in the process of creating, editing, and proofing printer-ready files, which can then be automatically directed to printing offices for printing. (See specification at page 2, lines 16-28.)

B. Claims 1 and 7 Are Not Obvious Over Hansen in View of Bowman-Amuah

In order to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the references must teach or suggest all limitations of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). In addition, there must be a suggestion or motivation to modify a reference. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991.) Here, neither

Hansen nor Bowman-Amuah, taken alone or in combination, teach or suggest at least each of the limitations of claims 1 and 7. Nor is there a motivation to modify Hansen in view of Bowman-Amuah.

1. Hansen

Hansen discloses a system and method for providing production printing instructions for a printed end document to a job preparation station. The printed end document is made up of other documents received from the customer that are inserted by the print shop based on the customer's instructions. (Abstract.)

Thus, Hansen discloses that a customer can send static document(s) and production specifications to a print shop. Unlike embodiments of the present invention, the print shop, not the customer, creates and edits the final document to be printed.

On page 4 of the Office Action, the Examiner admitted that Hansen does not disclose that "a PDF engine creating documents uses first and second XML files to create a customer PDF document for printing on demand." Thus, the Examiner has admitted that Hansen does not disclose:

generating, by a PDF engine using first and second XML files, a customer PDF document for printing on demand; wherein

the first XML file comprises data and its data type for printing which is created by the customer through said interface;

the second XML file comprises a description of how said data is to be positioned and formatted, in a created document by the customer through said interface;

wherein said PDF document generating comprises analyzing the first and second XML files, merging data, and formatting information;

Therefore, the Examiner has admitted that Hansen lacks substantially all the features of independent claims 1 and 7.

Moreover, Hansen also does not disclose, among other things, that such a “PDF document generated using the first and second XML files is generated at the site of the customer.” On page 4 of the Office Action, the Examiner asserted that Hansen “teaches that the service provider is capable of interpreting PDF data received by the customer. Therefore, it can be concluded that a user can generate a PDF data.” However, Applicants’ claims recite not simply generating a PDF document, but generating a PDF document in a particular manner that uses first and second XML files.

On pages 3 and 4 of the Office Action, the Examiner referred to Hansen at col. 17, lines 22-30, which describes the use of XML to implement mobile page features. However, such functionality is available to the print shop, not to the customer, and is visually represented on the desktop 302 of the production printing workflow management application. (See also FIG. 3; col. 12, lines 47-62.) Therefore, use of XML in Hansen merely relates to a print shop’s preparation of the final printer-ready document, not to a customer’s generation of a PDF document.

2. Bowman-Amuah

The Examiner asserted that Bowman-Amuah remedies the deficiencies of Hansen. In particular, the Examiner asserted that Bowman-Amuah “discloses a benefit of XML documents consisting [of] two parts.” Bowman-Amuah discloses the following with respect to XML:

HTML 4.0 and Dynamic HTML have given Web authors more control over the ways in which a Web page is displayed. But they have done little to address *a growing problem in the developer community: how to access and manage data in Web documents so as to gain more control over document structure. To this end, leading Internet developers devised Extensible Markup Language (XML)*, a watered-down version of SGML that reduces its complexity while maintaining its flexibility. Like SGML, XML is a meta-

language that allows authors to create their own customized tags to identify different types of data on their Web pages. In addition to improving document structure, *these tags will make it possible to more effectively index and search for information in databases and on the Web.*

XML documents consist of two parts. The first is the document itself, which contains XML tags for identifying data elements and resembles an HTML document. The second part is a DTD that defines the document structure by explaining what the tags mean and how they should be interpreted. *In order to view XML documents, Web browsers and search engines will need special XML processors called "parsers."*

(Col. 41, lines 1-24; emphasis added.) Therefore, Bowman-Amuah merely describes benefits of using XML in connection with the viewing, indexing, and searching of World Wide Web documents. Applicants note that Bowman-Amuah is not at all related to the generating and printing of PDF documents using XML files. Moreover, Bowman-Amuah is highly general in nature, simply providing background information about web-based XML documents.

The Examiner states that “[a]lthough the reference uses the first and second XML files in customizing user’s web pages, it is well known in the art at the time of the invention that these XML web pages can be saved and transmitted to other computers upon the user’s request for further printing purposes.” Thus, the Examiner concludes that “it would have been obvious ... to implement the Bowman-Amuah method of using the first and second XML files to the Hansen method of creating print data by embedding XML within PDF file.”

(Pages 4 and 5 of Office Action.)

Applicants respectfully disagree with the Examiner’s conclusion. “If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Applicants submit that modifying Hansen to use the XML documents of Bowman-Amuah would render Hansen inoperable for its intended purpose. The reason is that the

highly general teachings of Bowman-Amuah with regard to XML and printable XML web documents, even if applied in Hansen, could not allow a customer to edit and generate a printable PDF document, as provided by embodiments of Applicants' invention.

Specifically, unlike an XML web page of Bowman-Amuah, which can be readily created and printed on a desktop printer, a professional printer-ready PDF document according to Applicants' claimed invention must be generated using a far more complex technique involving tagging into the document XML information from two files so that the document may be printed. Among other things, Bowman-Amuah in no way discloses techniques involving XML tags relating to, for example, printing colors, overlaps and swelling of text, cutting marks, paper, layout on page, images and illustrations, and font and size for a specific element. Without these and other techniques, a user in a modified Hansen system could not edit or generate a printable PDF document using XML.

3. Conclusion with Respect to Claims 1 and 7

For at least the above reasons, Applicants respectfully submit that the Examiner has failed to set forth a prima facie case of obviousness. Thus, the Examiner's rejection should be withdrawn.

C. Claims 2-6 and 8-12

Claims 2-6 and 8-12 respectfully depend from independent claims 1 and 7. For at least the above reasons, claims 2-6 and 8-12 are not obvious over Hansen in view of Bowman-Amuah.

Appl. No. 09/612,919
Amdt. dated April 6, 2004
Reply to Office Action of November 6, 2003

All outstanding matters having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

By: Carlo Cothran 48,715
for Caroline D. Dennison
Reg. No. 34,494
Telephone: (703) 905-2047

PILLSBURY WINTHROP LLP
1600 Tysons Boulevard
McLean, Virginia 22102
Switchboard: (703) 905-2000
Office fax: 703-905-2500